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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,480

12/13/2004

Hudson Freeze

UCSD-08831

4479

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01/21/2010

EXAMINER

MACAULEY, SHERIDAN R

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

01/21/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,480	Applicant(s) FREEZE ET AL.	
	Examiner SHERIDAN R. MACAULEY	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 136, 144-152, 154, 155, 157-159, 162-164 and 167-176 is/are pending in the application.
- 4a) Of the above claim(s) 144-152, 154, 155, 157-159 and 162-164 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 136 and 167-176 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A response and amendment were received and entered on October 7, 2009. Claims 136, 144-152, 154, 155, 157-159, 162-164 and 167-176 are pending. Claims 144-152, 154, 155, 157-159 and 162-164 have been withdrawn due to a previous requirement for restriction. Applicant's claim amendments necessitate this new requirement for restriction. Claims 136 and 167-176 are subject to this requirement for restriction/election.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 7, 2009 has been entered.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

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Group I, claim(s) 136 and 170-176, drawn to a method for identifying a test agent.

Group II, claim(s) 167, drawn to a different method for identifying a test agent.

Group III, claim(s) 168, drawn to a different method for identifying a test agent.

Group IV, claim(s) 169, drawn to a different method for identifying a test agent.

3. The inventions listed as Groups I through IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature that is common to the inventions is: a method for identifying a test agent comprising: (A) providing: (i) a carboxylated glycan purified by a method comprising (1) providing (a) a molecule comprising a carboxylated glycan; (b) biotinylated diamino pyridine (BAP); and (c) an exoglycosidase; (2) conjugating said molecule to said BAP to produce a BAP-glycan conjugate; (3) treating said BAP-glycan conjugate with said exoglycosidase to produce a first treated BAP-glycan conjugate comprising a first anionic BAP-glycan conjugate having from 1 to 2 negative charges per molecule; and (4) isolating said first anionic BAP-glycan conjugate having 1 to 2 negative charges per molecule, thereby purifying a carboxylated glycan; (ii) an antibody that specifically binds to said carboxylated glycan, wherein said binding is not reduced by a carboxylate-neutralized glycan; and (iii) a test agent; (B) containing the purified carboxylated glycan, said antibody and said test agent; and (C) detecting a reduction in the level of binding of said antibody to said purified carboxylated glycan in the presence of said test agent compared to in the absence of said test agent.

4. However, this feature was obvious at the time of the invention, as taught by Varki et al. (US 5,449,781) and Hodges et al. (US 5,738,996) and discussed in the prior office action. Briefly, a carboxylated glycan purified by method (i) was known in the art, as taught by Varki. Varki also teaches methods for screening test agents that bind to antibodies using the purified glycans Hodges teaches a test method wherein a labeled antigen, which may be immobilized, is bound to an antibody and a test agent, wherein the reduction of the level of binding of the antibody to the antigen is detected and is indicative of specific binding of the test agent to the antigen (col. 13, lines 28-44, col. 14, lines 6-15). It would have been obvious to combine these teachings to arrive at the special technical feature recited above for the reasons recited in the prior office action; briefly, because the desirability and production of methods for the screening of proteins which bind to saccharides and the production of antibodies specific for the saccharides were well known at the time of the invention, and one of ordinary skill in the art would have recognized that the teachings of Hodges could have been applied to modify the method of Varki. Therefore, there is no special technical feature common to the groups that makes a contribution over the prior art.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHERIDAN R. MACAULEY whose telephone number is (571)270-3056. The examiner can normally be reached on Mon-Thurs, 7:30AM-5:00PM EST, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM

/Ruth A. Davis/

Primary Examiner, Art Unit 1651